

REMARKS

This Amendment has been submitted in response to the last Office action and supplementary to the previous Amendment.

The last Office Action has been carefully considered.

It is noted that claim 12 is rejected under 35 U.S.C. 103(a) over the patent to Bhagwat in view of the patent to Sakoh.

Claim 26 is rejected under 35 U.S.C. 103(a) over the patent to Bhagwat in view of the patent to Somers.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicants amended claim 12, the broadest claim on file, to restore its original language.

It is respectfully submitted that claim 12 clearly and patentably distinguishes the cordless screw driver of the present invention from the prior art applied by the Examiner.

Turning now to the references and in particular to the patent to Bhagwat, it is respectfully submitted that this reference does not disclose the new

features of the present invention, contrary to the Examiner's opinion. The patent to Bhagwat discloses a dual-mode system for operating electrically powered vehicles. The dual-mode system includes a cordless mode and a corded mode using a voltage converter, as explained for example in the Abstract. The patent to Bhagwat does not disclose a charger. Thus, the patent to Bhagwat does not show the following features which are not defined in claim 12:

- charging cradle assembly
- the cordless screwdriver and a rechargeable battery being configured so that the cordless screwdriver as a whole being placeable onto the charging cradle
  - which automatically initiates the charging mode
  - in the charging mode being positioned on the charging cradle so that the housing of the cordless screwdriver is inclined relative to a horizontal plane and an end of said output spindle points downwards.

The Examiner referred to Figure 4 of the patent to Bhagwat to show that a charging cradle is disclosed. However, this is not correct. This can be ascertained from column 5, lines 55-59 and column 10, lines 58-63. Figure 4 shows a container 72 which houses the converter. The container 72 is inserted into the chamber 32 at the lower end of the handle 22. The Examiner also refers to Figure 3 to show that the entire screwdriver is placed onto the charging cradle.

However, Figure 3 just shows the lower end of the handle 22 is a battery-pack container 28.

It is therefore believed to be clear that the above mentioned new features of the present invention are not disclosed in the patent to Bhagwat.

The feature that the charging cradle automatically initiates a charging mode when the screwdriver is placed onto the charging cradle is also not disclosed in the patent to Sakoh. The Examiner referred to column 1, lines 47-54, however, this is not correct. The patent to Sakoh discloses that charges continue to supply charging current even after the battery packs are fully charged. This does not mean that the charging mode starts automatically when the tool is placed onto the charger.

Thus, this reference also does not teach the features of the present invention as defined in claim 12.

As for the Examiner's rejection of claim 12 over the combination of the references, it is respectfully submitted that none of the references teaches the above mentioned new features of the present invention as defined in claim 12. The combination of the references can not be considered as obvious, and it would not lead to the applicant's invention as defined in claim 12. In order to arrive at the applicant's invention from the teachings of the references, the

references have to be fundamentally modified, and in particular by including into them the new features of the present invention, which are defined in claim 12, and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

It is therefore believed that claim 12 should be considered as patentably distinguishing over the art represented by these references and should be allowed.

The patent to Somers applied by the Examiner also does not teach the new features of the present invention as defined in claim 12.

As for the dependent claims, these claims depend on claim 12, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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